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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/786,502 | 05/18/2001 | Michel Sadclain | MSK.P-040 | 1539 |

52334 7590 03/09/2006

Marina Larson & Associates LLC
re: MSK
P. O. BOX 4928
DILLON, CO 80435-4928

EXAMINER

RAWLINGS, STEPHEN L

| ART UNIT | PAPER NUMBER |
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1643

DATE MAILED: 03/09/2006

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| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
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| ART UNIT | PAPER |
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20060303

DATE MAILED:

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Commissioner for Patents

Notice of Non-Responsive Amendment

1. The amendment filed September 15, 2005, is non-responsive for the following reason:

The Office action mailed September 21, 2005, required Applicant to cancel new matter, which was added by the amendment filed September 8, 2003.

Applicant has not complied with the requirement to cancel the new matter.

Instead, Applicant has argued that the amendment did not introduce new matter. Applicant has asserted that the ordinary meaning of the term “spanning” is “going across”, and therefore, given the original disclosure of the CD28 cytoplasmic domain, which is “particularly a fragment spanning amino acids 336 to 663 of CD28 cDNA”, it would be understood that the CD28 fragment comprises the amino acids encoded by bases including bases 336 to 663 of the cDNA encoding CD28.

In response, a span is the distance between two points¹; therefore, “spanning” would ordinarily be understood to mean, “extending from one point to another”². Contrary to Applicant’s assertion, the term “spanning” would not be understood to mean “extending from one point to another, *and beyond in either direction*”.

Again, as explained in Office action mailed September 21, 2005, the originally filed disclosures at pages 6 (lines 28 and 29), 7 (lines 15-17), and 15 (lines 5 and 6) do not provide written support for a genus of “CD28 cytoplasmic domains” that are encoded by fragments of CD28 encoded by portions of the polynucleotide sequence of the cDNA encoding CD28, which comprise nucleotides 336-663.

For further clarity, it is apparent that the originally filed disclosures at pages 6 and 7 contain errors, since each refers to residues 336-663 of the cDNA encoding CD28 as “amino acids”, rather than nucleotides. At page 7, Applicant has amended the disclosure to read, “[a] preferred CD28 moiety is one which spans amino acids encoded by bases 336 to 663 of CD28

¹ See, e.g., MERRIAM-WEBSTER ONLINE (www.Merriam-Webster.com), which provides the following definition of the noun “span”: “an extent, stretch, reach, or spread between two limits” (copyright 2005 by Merriam-Webster, Incorporated).

² See, e.g., MERRIAM-WEBSTER ONLINE (www.Merriam-Webster.com), which provides the following definition of the transitive verb “span”: “to extend across” (copyright 2005 by Merriam-Webster, Incorporated). “Spanning” is the inflected form of the transitive verb.

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cDNA". It is believed the amendment at page 7 is supported by the original disclosure at page 15 (lines 5 and 6), which reads, "[a] segment of the human CD28 cDNA that encodes part of the extracellular, the transmembrane, and the cytoplasmic domains (amino acids 336 to 663) was amplified [...]". However, in contrast to the original disclosure at page 15, as well as the amended disclosure at page 7, the amended disclosure at page 6 reads, "the CD28 cytoplasmic domain (particularly a fragment encoded by bases **including** bases 336 to 663 of CD28 cDNA" (emphasis added).

Again, the originally filed disclosure does not provide written support for a genus of "CD28 cytoplasmic domains" that are encoded by fragments of CD28 encoded by portions of the polynucleotide sequence of the cDNA encoding CD28, which comprise nucleotides 336-663. The originally filed disclosure merely provide written support for the CD28 cytoplasmic domain, which is the fragment of CD28 encoded by nucleotides 336 to 663 of the full-length cDNA molecule encoding intact CD28.

2. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1643

slr
March 3, 2006